

REMARKS

The Final Office Action dated October 28, 2009 has been received and reviewed. Prior to the present communication, claims 1-48 were pending in the subject application. Each of claims 1, 5, 6, 23, 35, 37, 43, and 45 has been amended herein. Claims 17-22 and 47 have been canceled herein. Accordingly, claims 1-16, 23-46, and 48 remain pending. Support for the amendments may be found in the Specification, for instance, at FIGS. 6, 7, and 11 and ¶¶ [0029], [0031], [0059], [0061]-[0063], and [0067]-[0069]. Care has been exercised to introduce no new matter. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

Objections

Claim 1 has been objected to for grammatical ambiguities. Applicants appreciate the Examiner's suggestions with respect to claim 1, and have amended claim 1 to remove said ambiguities. Applicants respectfully request the withdrawal of the objections to claim 1.

Rejections based on 35 U.S.C. § 112

Claims 15-16, 23-34, 35-36, 44-45, and 48 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the claims were said to include subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, has possession of the claimed invention. *See Office Action dated 10/28/2009*, p. 4. Applicants respectfully traverse this rejection.

Independent claim 15 recites, in part, displaying details associated with a satisfier. As shown in Figs. 4 and 6, and as described in at least ¶¶ [0061]-[0063] of the present

application, No. 10/750,478, a healthcare provider selects a therapy to satisfy an expectation for a health maintenance item and, in embodiments, “the system displays detailed information 600 for the satisfier for the health maintenance item selected.” In one example, “[i]f the satisfier for a hemocult result 716 is selected, screen 800 of FIG. 8 is opened.” *See* Appl. No. 10/750,478, ¶ [0063]. In another example, Fig. 6 shows details associated with an Aspirin therapy satisfier displayed on a separate screen on a user-interface.

Independent claim 23 recites, in part, displaying one or more details of a satisfied expectation. Independent claim 48 includes displaying information associated with a satisfier. As stated in ¶ [0062] of the present application, No. 10/750,478, “[m]ore information may be obtained for a recently satisfied expectation by selecting the expectation.” As shown in Fig. 11 of the present application, the satisfier “Colorectal Screening” is displayed in a second screen on an interface. Detailed information that may be displayed in Fig. 11 includes a date, comments, and an individual’s identity. Additionally, Fig. 6 shows detailed information such as a prescription date and that no allergies have been recorded for this patient. With reference to FIG. 6, the system displays detailed information 600 for the satisfier for the health maintenance item selected. *See* Appl. No. 10/750,478, ¶ [0062].

Independent claim 44 recites, in part, a window on an interface that includes additional information about an unsatisfied health maintenance item. As shown in Figs. 8, 9, 12, 13, and 14, and described in at least ¶¶ [0063] and [0067]-[0069] of the present application, a window with additional information about an unsatisfied health maintenance item is displayed in embodiments. For example, in Fig. 8, the health maintenance item colorectal screening has not been documented as satisfied, and screen 800 is opened to display input areas for hemocult results. The additional information in screen 800 includes additional information about an

unsatisfied health maintenance item, such as the number of slides and possible outcomes for “stool occult blood results.” *See* Appl. No. 10/750,478, Fig. 8. In embodiments, additional information about the postponement or expiration of satisfiers for an unsatisfied health maintenance item is displayed in a window on an interface. *See, for example*, Appl. No. 10/750,478, Figs. 12-14 and ¶ [0068] (“If postponement box 714 is selected in FIG. 7, screen 1204 of FIG. 12 is opened.”).

Independent claims 35 and 45 have been rejected under § 112 based on displaying a priority level said to be new matter. *See Office Action dated 10/28/2009*, p. 4. Claims 35 and 45 have been amended to clarify that a priority level of an unsatisfied health maintenance item is displayed. Support for amendments may be found, at least, at ¶¶ [0059] and [0061], and Figures 4 and 5, of the present application, No. 10/750,478. In one example, “[f]or each pending expectation, the priority 416 of the expectation is listed and the due date of satisfying the expectation 418 is also shown. Referring to pending expectation for ischemic heart disease prevention 422, the health maintenance item is a high priority and is overdue.”

Therefore, Applicants respectfully submit that independent claims 15, 23, 35, 44, 45, and 48 comply with the written description requirement of 35 U.S.C. 112, first paragraph. Applicants respectfully request withdrawal of the rejections under § 112 against independent claims 15, 23, 35, 44, 45 and 48, and dependent claims 16, 24-34 and 36, for at least the reasons given above.

Claims 23-43 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 23, 35, 37, and 43 have been amended to recite, for example, a computerized system embodied on one or more computer readable media

that include one or more modules. Support for amendments to independent claims 23, 35, 37, and 43 are supported, at least, at ¶¶ [0029] and [0031] of the present application, No. 10/750,478. Applicants respectfully submit that claims 23-43 disclose structure embodying modules, and that the § 112 rejections against claims 23-43 have been overcome.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere*, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant's disclosure must be put aside in reaching this determination [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. Moreover, the Federal Circuit has stated that “‘rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness.’” MPEP § 2142 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

When combining references, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, each prior art reference “must be

considered in its entirety, i.e., as a whole, **including portions that would lead away** from the claimed invention.” MPEP § 2141.02 (citation omitted) (emphasis added).

B. Rejections Based on Merkin and Dvorak

Claims 1-7, 15-16, 23-36, and 43-46 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,464,041 to Merkin, et al. (hereinafter the “Merkin reference”) in view of U.S. Publication No. 2003/0208391 to Dvorak, et al. (hereinafter the “Dvorak reference”).

Applicants submit herewith a Declaration under 37 C.F.R. § 1.131 of the coinventors, Jeffrey S. Doyel, D. Allan Shoup, James J. Wagner, and Jennifer A. Ducey. The Declaration includes, as Exhibit A, a copy of screen shots dated June 10, 2003 illustrating the claimed invention, which shows conception and reduction to practice prior to the reference date of October 3, 2003.

The Declaration, together with Exhibit A, establishes that the subject matter set forth in claims 1-16, 23-46, and 48 of the present application was conceived and reduced to practice before the reference date of October 3, 2003 of U.S. Patent No. 7,464,041, the Merkin reference, and that diligence was practiced to reduce the invention to practice by December 31, 2003. Accordingly, Applicants submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 1-7, 15-16, 23-36, and 43-46 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin and Dvorak references.

C. Rejections Based on Merkin, Dvorak, and Kelly

Claims 8-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Merkin reference in view of the Dvorak reference in further view of U.S. Publication

No. 2004/0243619 to Kelly, et al. (the “Kelly reference”). For the reasons set forth above, Applicants respectfully submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 8-14 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin, Dvorak, and Kelly references.

D. Rejections Based on Medvedeff, Edelson, and Dvorak

Claims 17-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0154107 to Medvedeff (hereinafter the “Medvedeff reference”) in view of U.S. Patent No. 5,737,539 to Edelson (hereinafter the “Edelson reference”) in further view of the Dvorak reference. Claims 17-20 have been canceled by way of the present communication and, thus, the rejection of these claims has been rendered moot.

E. Rejections Based on Merkin, Edelson, and Dvorak

Claims 37-42 and 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Merkin reference in view of U.S. Patent No. 5,737,539 to Edelson (hereinafter the “Edelson reference”) in further view of the Dvorak reference. For the reasons set forth above, Applicants respectfully submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 37-42 and 48 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin, Edelson, and Dvorak references.

F. Rejection Based on Medvedeff and Dvorak

Claim 47 has been rejected under 35 U.S.C. 103(a) as being unpatentable over the Medvedeff reference in view of the Dvorak reference. Claim 47 has been canceled by way of the present communication and, thus, the rejection of this claim has been rendered moot.

CONCLUSION

For at least the reasons stated above, claims 1-16, 23-46, and 48 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or asturgeon@shb.com (such communication via email is herein expressly granted) – to resolve the same.

Submitted herewith is a Declaration under 37 C.F.R. § 1.131, a Petition for a Three-Month Extension of Time, and a Request for Continued Examination, along with the appropriate fees. It is believed that no additional fee is due, however, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket number CRNI.110337.

Respectfully submitted,

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